

FULL TEXT OF CASES (USPQ2D)

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**R.A.C.C. Industries Inc. v. Stun-Tech Inc. (CA FC) 49
USPQ2d 1793 R.A.C.C. Industries Inc. v. Stun-Tech
Inc.**

**U.S. Court of Appeals Federal Circuit
49 USPQ2d 1793**


**Decided December 2, 1998 (Unpublished)
No. 98-1186**

Headnotes

PATENTS

1. Patent construction -- Claims -- Process (§ 125.1309)

Patent construction -- Claims -- Functional (§ 125.1311)

 Apparatus claim may include functional limitations, and functional language in apparatus claim may be interpreted as requiring that accused apparatus possess capability of performing recited function; however, functional language in apparatus claim does not convert such claim into method of use or hybrid claim.

2. Patent construction -- Claims -- Process (§ 125.1309)

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Patent construction -- Claims -- Functional (§ 125.1311)

Recitations concerning concealability in asserted claims for prisoner stun belt do not convert claims into method of use claims, since prosecution history shows that applicant was unable to distinguish its invention from prior art based solely on intended use, and that applicant successfully overcame prior art only by adding structural limitation; claims do recite concealability as necessary limitation, however, since functional language "adapted for concealment" and "means concealable beneath said appropriate clothing," although not requiring concealment in actual use, limits scope of claims

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to devices that have capability of being concealed.

3. Patent construction -- Claims -- Broad or narrow (§ 125.1303)

Federal district court correctly construed apparatus claims for prisoner stun belt restraint to cover apparatus that is not "noticeable, observable, or discernible as a prisoner control apparatus," since claim language, which recites mounting means "adapted for concealment" to "prevent said prisoner from being marked by observers in said social context as a person under restraint," emphasizes mounting means adapted for concealment in courtroom setting, since specification further clarifies that this language provides means for controlling dangerous persons in public trial "without the stigma of visible restraints," and since during prosecution of patent, applicant stated that stun belt would allow prisoner freedom of movement without need for "the prisoner's restraint becoming noticeable" to observer.

4. Infringement -- Construction of claims (§ 120.03)**Infringement -- Literal infringement (§ 120.05)**

Federal district court properly granted summary judgment that plaintiff's patent for prisoner stun belt restraint is infringed by defendant's accused device, since court correctly determined that asserted claims require only that ordinary observer would not identify apparatus of patent as prisoner control device when worn under ordinary clothing, and therefore appropriately concluded that noticeable bulge under clothing when accused device is secured to prisoner's torso does not remove device from scope of claims.

Particular patents -- Electrical -- Prisoner control device

4,943,885, Willoughby and Roy, remotely activated, nonobvious prisoner control apparatus, summary judgment of infringement affirmed.

Case History and Disposition:

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**Appeal from the U.S. District Court for the District of Maryland,
Chasanow, J.**

Action by R.A.C.C. Industries Inc. against Stun-Tech Inc., Dennis Kaufman, and Leo R. Ward for patent infringement, in which defendant Stun-Tech Inc. counterclaimed against plaintiff, Carl W. Roy II and Brian D. Willoughby. From grant of summary judgment of infringement, defendants Stun-Tech Inc. and Dennis Kaufman appeal. Affirmed.

[Editor's Note: The U.S. Court of Appeals for the Federal Circuit has indicated that, " [p]ursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record."]

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James F. McKeown, of Evenson, McKeown, Edwards & Lenahan, Washington, D.C.; Christopher G. Hoge, of Crowley, Hoge & Fein, Washington, for appellees.

Judge:

Before Rich, Rader, and Schall, circuit judges.

Opinion Text**Opinion By:**

Rader, J.

The United States District Court for the District of Maryland granted summary judgment of infringement of a patent on remotely activated stun belts for restraining prisoners. R.A.C.C. Industries, Inc. (RACC) initiated this action against Stun-Tech, Inc. and its president, Dennis Kaufman, (collectively Stun-Tech) alleging infringement of its U.S. Patent No. 4,943,885 (the '885 patent).

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After preliminary hearings and construction of the claims by the district court, both parties moved for summary judgment. The district court granted summary judgment in favor of RACC. The district court enjoined Stun-Tech from making, using, selling or otherwise distributing its Minimum Security Belt (MSB) and High Security Transport Belt (HSTB), both sold under the name "R-E-A-C-T Belt System," during the remainder of the life of the '885 patent. Stun-Tech appeals the district court's claim construction and the finding of infringement of the '885 patent. Because the district court did not err in its construction of the claims of the '885 patent nor in its entry of summary judgment, this court *affirms*.

I.

The '885 patent discloses a remotely activated, nonobvious (i.e., concealable) prisoner control apparatus. The prisoner control apparatus of the '885 patent is a torso-mounted stun belt which delivers an incapacitating electric shock to a disruptive prisoner wearing the belt when activated. The stun belt includes a radio receiver and a stun unit. The stun unit has several electrodes which are placed against the prisoner's body to deliver the electric shock. A radio transmitter remotely activates the stun belt to incapacitate

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the disruptive prisoner. To accommodate constitutional due process concerns and facilitate fair trials for dangerous prisoners, the stun belt of the '855 patent is capable of being concealed under ordinary clothing. This feature allows use of the belt in a courtroom or other public setting without identifying the prisoner as being under restraint.

On or about October 1, 1990, Stun-Tech entered into an exclusive license agreement with RACC. The license agreement gave Stun-Tech the exclusive right to manufacture and sell the stun belt embodied in the '885 patent in exchange for royalty payments. Stun-Tech later ceased royalty payments contrary to this agreement after it redesigned its stun belts in an attempt to evade the '885 patent claims. In this attempt, Stun-Tech placed the radio receiver and stun package in a single pouch which produces a noticeable bulge when worn under a prisoner's clothing. With this change, Stun-Tech hoped to evade the portions of the patent claims concerning concealability. RACC terminated the license agreement on December 28, 1992 and subsequently instituted this action against Stun-Tech for infringement of the '885 patent.

The '885 patent claims at issue include independent claims one and four. Claim one recites:

1. Apparatus for control of a dangerous prisoner to prevent unpredictable dangerous actions by said dangerous prisoner while in social context situations *while nevertheless concealing such apparatus from public view*, comprising:
incapacitant delivery means,
torso mounting means comprising a belt of sufficient extent to encircle a prisoner's torso and means for securing said incapacitant delivery means in contact with said prisoner's torso,
said mounting means *being adapted for concealment beneath garments ordinarily worn by ordinary persons* in said social context *to prevent said prisoner from being marked*

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by observers in said social context as a person under restraint,
said incapacitant delivery means being powered to deliver an incapacitating electrical shock to said prisoner,
said mounting means further including means for receiving a remotely activated signal, and
means in said mounting means responsive to said signal for delivering said incapacitating electrical shock to said prisoner.
(emphasis added). Claim four provides:

4. *Nonobvious prisoner control apparatus* for operation by a controlling authority located remotely from a prisoner, while said prisoner is in clothing both appropriate to a public situation, and permitting normal functions of movement by said prisoner comprising:

means concealable beneath said appropriate clothing of said prisoner to [] be controlled, securely banded around said prisoner [']s torso, for delivery of a nonlethal disabling electrical impulse to said prisoner,
means connected to said electrical impulse delivery means for receiving a signal, including means for activating said electrical impulse delivery means upon receipt of said signal, and
means, operable by said controlling authority, for generating and transmitting said signal for activating said electrical impulse delivery means to disable said prisoner.
(emphasis added).

Stun-Tech presented two primary arguments as to why its stun belts did not infringe these claims, both focusing on the concealability limitations. First, Stun-Tech argued that combination of the radio receiver and stun package in a single pouch produce a noticeable bulge when worn under clothing. Therefore, Stun-Tech urged, they are not "adapted for concealment" or "concealable" as required by the '885 patent claims. Second, Stun-Tech argued that the claim language about concealability created a hybrid apparatus and method of use claim which requires concealment in actual use. Stun-Tech asserted that its belts are primarily used in open prisoner transport situations often in combination with handcuffs and shackles -- far from a concealment situation. Because of this allegedly non-infringing use, Stun-Tech sought to avoid direct infringement.

The district court did not agree with either of Stun-Tech's contentions. The district court rejected Stun-Tech's proposed "hybrid" claim interpretation, instead construing both claims solely as apparatus claims. According to the district court, Stun-Tech provided "absolutely no citation to authority [for its argument] that the R-E-A-C-T belts cannot infringe on the '885 patent because they are designed to be worn outside of the clothing." The district court added that "Stun-Tech's own characterization of how its product ought to be used cannot change the fact that the product otherwise infringes every element of the claims."

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The district court then construed the concealability limitations to require only that the stun belts "when worn under clothing ordinarily worn by a defendant in social situations [not] be noticeable, observable, or discern [ible] *as a prisoner control apparatus.* " The

district court stated that "the apparatus must be concealable 'beneath garments ordinarily worn by ordinary persons in said social context *to prevent said prisoner from being marked by observers in said social context as a person under restraint*.'" The district court continued: "This objective can be achieved by concealing the nature of the device while it is not necessary to conceal the very existence of the device." Based on this claim interpretation, the district court found that even though the accused devices produced a noticeable bulge under a prisoner's clothing, this did not avoid infringement of the '885 patent. The district court therefore granted RACC's motion for summary judgment. Stun-Tech appeals both the district court's claim interpretation and its grant of summary judgment of infringement.

II.

This court reviews issues of claim construction *de novo*. See *Cybor Corp. v. FASTech, Inc.*, 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (in banc). With respect to the district court's grant of summary judgment, this court reviews for itself the requirements for summary judgment. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986). In making that review, this court enforces the requirement that a trial court may not enter summary judgment in a case with material facts in dispute. See Fed. R. Civ. P. 56(c). Further, in a summary judgment proceeding, the trial court initially, and this court on review, construes all factual inferences and resolves all doubts in favor of the non-moving party. See *Anderson*, 477 U.S. at 255; *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307, 46 USPQ2d 1752, 1755 (Fed. Cir. 1998).

[1] On appeal, Stun-Tech asserts that the district court erred in its claim interpretation. Stun-Tech argues that claims one and four should be construed as hybrid apparatus and method of use claims. Stun-Tech further contends that these claims, when properly construed, cannot be infringed unless the accused device is used according to method of use limitations in the claims. Stun-Tech cites *In re Benson*, 418 F.2d 1251, 164 USPQ 22 (CCPA 1969), *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971), and *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 USPO2d 1557 (Fed. Cir. 1988) in support of its unique hybrid claim argument. These cases, however, do not authorize this court to transform an apparatus claim into a hybrid apparatus and method of use claim. Rather, these cases merely acknowledge that an apparatus claim may include functional limitations. Similarly, in *Intel Corp. v. U.S. International Trade Commission*, 948 F.2d 821, 832, 20 USPQ2d 1161, 1171 (Fed. Cir. 1991), this court interpreted functional language in an apparatus claim as requiring that an accused apparatus possess the capability of performing the recited function. This court has never determined that functional language in a claim converts an apparatus claim into a method of use or hybrid claim.

[2] Although claims one and four of the '885 patent contain recitations about concealability, the prosecution history demonstrates that this language does not make these claims method of use claims. Specifically, the prosecution history shows that the Examiner initially rejected all of the application's claims based on U.S. Patent No. 4,089,195 (Lai) which discloses a stun device in handcuffs. In response, RACC attempted to establish patentability of its claims over Lai based solely on intended use: By contrast the applicants' device can be worn comfortably by the prisoner without

restriction of the prisoner's freedom of movement and without the need for the prisoner's restraint becoming noticeable to even the closest observer.

The Examiner rejected RACC's argument, however, and again rejected the claims based on Lai, noting that the concealability of the apparatus did not change the fact that the claims did not recite any structure different from Lai. Accordingly, RACC then amended its claims to recite structural differences from Lai, namely, a belt of sufficient length to fasten around the torso. With the addition of this structural limitation, the Examiner allowed the claims.

This prosecution history shows that RACC was unable to distinguish its invention from the prior art based solely on intended use. Only by adding the structural limitation requiring torso mounting did RACC successfully overcome the prior art. Accordingly, the district court correctly decided that the functional language in claims one and four does not convert them into method of use or hybrid claims.

The claims do, however, recite concealability as a necessary limitation. Claim 1 recites a mounting means "adapted for concealment" while claim 4 recites a "means concealable

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beneath said appropriate clothing." This functional language limits the scope of these claims to devices that have the *capability* of being concealed. *See Intel Corp.*, 946 F.2d at 832 (Regarding patent claims to an EPROM, "the accused device, to be infringing, need only be capable of operating in the page mode [A]ctual page mode operation in the accused device is not required."). The district court therefore also correctly construed claims one and four as requiring the capability of being concealed although not requiring concealment in actual use.

[3] Furthermore, the district court correctly construed the apparatus claims to cover an apparatus not "noticeable, observable, or discernible *as a prisoner control apparatus*." The specification, the prosecution history, and, most importantly, the claims themselves support this reading. The language of claim one is particularly telling. Claim one recites "mounting means . . . adapted for concealment . . . to prevent said prisoner from being marked by observers in said social context *as a person under restraint*." '885 patent, col. 9, ll. 1-5 (emphasis added). Thus, this language emphasizes a mounting means adapted for concealment in a courtroom setting. The specification of the '885 patent further clarifies that this language provides "means for control of dangerous prisoners in public trial . . . without the stigma of visible restraints so as to enable the restrained accused to appear as a normal, ordinary member of society." *Id.* at col. 3, ll. 15-19. Furthermore, during prosecution of the '885 patent, RACC stated that its belt would allow a prisoner's freedom of movement, "without the need for *the prisoner's restraint becoming noticeable*, to even the closest observer." (emphasis added). These defining statements support the district court's conclusion that the concealment limitations specify an apparatus not "noticeable, observable, or discernible *as a prisoner control apparatus*." The district court correctly determined that these claims require only that an ordinary observer would not identify the apparatus as a prisoner control device when worn under ordinary clothing. The district court therefore appropriately concluded that the noticeable bulge under the clothing when the accused device is

secured to a prisoner's torso does not remove the accused device from the proper scope of the claims.

[4] Stun-Tech challenged the district court's grant of summary judgment of infringement solely on the district court's alleged error in claim construction. Stun-Tech did not show that a genuine issue of material fact precludes summary judgment. Because this court agrees with the district court's claim construction, and because this court further agrees with the district court that no genuine issue of material fact bars the grant of summary judgment of infringement, the decision of the district court is affirmed.

- End of Case -

